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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,603	03/11/2004	Ayumi Hirayama	116692005300	3877

25227 7590 07/20/2009  
MORRISON & FOERSTER LLP  
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MCLEAN, VA 22102

EXAMINER
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BUCHANAN, CHRISTOPHER R

ART UNIT	PAPER NUMBER
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3627

MAIL DATE	DELIVERY MODE
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07/20/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/797,603	<b>Applicant(s)</b> HIRAYAMA ET AL.	
	<b>Examiner</b> CHRISTOPHER R. BUCHANAN	<b>Art Unit</b> 3627	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-8, 10-12 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-8, 10-12 and 14-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 15, 2009 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 6-8, 10-12, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Timmons et al. (US 2004/0088190) alone.

Regarding claims 6, 10, and 14, Timmons discloses an expense management system including a business partner terminal (PCP, 800, Fig. 2) that sends invoice information (includes billing or debit note data, par. 15, par. 25) and an expense management apparatus (healthcare facility, 700, Fig. 2) that manages the received invoice information (par. 18), wherein the expense management apparatus includes an

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expense master database (data warehouse, par. 14, 16, healthcare facility has access to data warehouse which is interpreted to mean 'including' the database, physical location of database is a matter of design choice) storing master information for business partners (dataset includes patient census data, transaction data, healthcare facility information, items sold, price charged, etc., par. 6, 14), means to calculate debit information (determines charges in their records, par. 18, facility reviews invoice and determines if it is accurate, par. 25) based on the invoice information and stored expense master information of a business partner (facility examines charges on invoice, par. 18, expense information is used to generate invoice) thereby generating calculated debit information (facility must have something to compare to invoice data), and accuracy determining means for comparing the calculated debit information with the debit information sent from the business partner terminal (charges on invoice are compared to their records, par. 6, par. 18, facility determines if invoice is accurate, i.e., if various charges are correct, par. 25) and determining whether the sent debit information corresponds to the calculated debit information (looks for discrepancies or errors, par. 6, par. 18, par. 25).

The system of Timmons differs from the claimed invention in that the business partner is not explicitly shown to be associated with the business partner terminal apparatus.

However, the business partner could be associated with any number of entities without affecting the functioning of the invention. The particular entity to which the business partner is associated would not affect the nature or functioning of the invention

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and has not been shown to serve any particular purpose or solve any stated problem, thus would be a matter of design choice.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Timmons so that the business partner is associated with the business partner terminal apparatus, as suggested by design choice, to provide a means for organizing and classifying relevant data which are used for expense management.

Regarding claim 7, the apparatus includes a notification means to send a verification request to the business partner terminal when it is determined that the calculated and sent debit information do not correspond (facility may request a credit memo if discrepancies are found, par. 18). Regarding claim 8, the apparatus includes estimation means (past records, par. 18) for determining debit information without using invoice information. Regarding claims 11, 12, 15, and 16, the features of the invention recited in these claims have already been addressed in the rejection above.

### ***Response to Arguments***

4. Applicant's arguments filed on April 15, 2009 have been fully considered but they are not persuasive. Applicant argues that the prior art reference does not disclose all the recited features of the claimed invention. In particular, applicant argues that the Timmons reference does not disclose a calculation means for calculating debit information based on invoice information and stored expense master information or an

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accuracy determination means for comparing calculated debit information with debit note information.

The examiner disagrees and stands by the rejection. As stated in the rejection above, Timmons shows an expense management apparatus (health care facility) that receives invoice and debit note information (i.e., the invoice with an itemized list of items ordered, individual charges and the total bill, par. 14, 15). The apparatus examines charges listed on the invoice and compares them to their records to determine if there are any discrepancies (par. 18, includes finding discrepancies within the invoice itself not just the total charge) to determine if the invoice is accurate (par. 25 line 9-10, accuracy determining means). Among other things, this process would involve performing calculations on various quantities listed on the invoice along with the expense master information (individual prices, quantities, totals, etc.) to determine if charges, etc., listed on the invoice are accurate. This would produce calculated debit information which is compared with debit information on the bill and would require a calculation means. In the examiner's view, this is standard accounting procedure, in common practice, used to determine the accuracy of a bill which includes a number of different items and separate charges.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER R. BUCHANAN whose telephone

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number is (571)272-8134. The examiner can normally be reached on Mon.-Fri. 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. R. B./  
Examiner, Art Unit 3627

/F. Ryan Zeender/  
Supervisory Patent Examiner, Art Unit 3627